

RESPONSE TO OFFICE ACTION  
Appln. No. 10/597,022  
Response Filed January 25, 2010

Attorney Docket No. 22727/04418

**Remarks**

In the specification, the title has been amended to correct deviation from the original title that appears to have been introduced during publication of the patent application by the USPTO as Patent Publication No. 20070225373. The amendment has been made to return the title to its original form, as found in WO 2005/055928, and does not constitute new matter.

Claims 1-25 were pending in the above-identified application. By way of the present amendment, Applicants have amended claims 1, 3 and 8-15 and have cancelled claims 2, 4-5, 18-19, and 25. Claims 1, 3, 6-17, and 20-24 are therefore currently pending and under examination. Applicants respectfully request reconsideration and allowance of the pending claims in view of the amendments and the remarks provided herein.

**Claim Rejections under 35 U.S.C. §112, 2nd paragraph**

The Examiner has rejected claims 1-25 under 35 U.S.C. §112, second paragraph, as being indefinite. Applicants respectfully traverse the rejections.

Claim 1 was rejected based on its inclusion of the phrase “Z is chosen from (CH<sub>2</sub>)<sub>m</sub> wherein m is 0-3 and (CH)<sub>2</sub>.” Applicants respectfully assert that this phrase is proper and definite, and indicates that Z can be chosen from two options; either (CH<sub>2</sub>)<sub>m</sub> where m is 0-3, or (CH)<sub>2</sub>, which represents an alkene group (sometimes represented as -CH=CH-). The same form of phrase is used elsewhere in the claim for X, which can be chosen from H and CH<sub>3</sub>, which the Examiner has not rejected. Applicants do note that the addition of the wherein clause “wherein m is 0-3” does make the phrase more complex than what is seen for X, and would be willing to amend the claim to include a comma or other minor change that the Examiner might suggest if it is felt that such additional clarification would be helpful.

Claim 1 was also rejected based on its inclusion of the term “A is a hydrocarbyl group,” with the further indication that the compounds could indicate any range of carbon and hydrogens. Applicants have amended the claims to remove the term “hydrocarbyl group”

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thereby rendering the rejection moot.

Claims 2, 4-5, 8 and 25 were rejected on the basis of including the phrase “A comprises” or “R comprises.” Applicants have cancelled claims 2, 4-5 and 25, and have amended claim 8 to replace “comprises” with “is.”

Claims 2-5, 8 and 25 were rejected for reciting the phrases “an aliphatic group” or “an aromatic group,” with the further indication that the range of carbon atoms was lacking. Applicants have amended the claims to recite aliphatic or aromatic groups including from 3 to 14 carbons, support for which is found in paragraph 43. Applicants further note that group A represents the hydrocarbyl portion of the fatty acids used in the preparation of the compounds of the invention, but that only the carbonyl of the carboxyl group of the fatty acid is retained after reaction with the amine. Accordingly, the description of the hydrocarbyl and carboxylic acid portions of fatty acids relates to the composition of A.

Claims 5 and 25 were rejected for reciting the phrase “substituted.” Claims 5 and 25 have been cancelled, rendering the rejection moot.

Based on the comments and amendments to the claims provided above, Applicants respectfully request that the rejection of claims 1-25 under 35 U.S.C. §112, second paragraph, be withdrawn.

#### **Claim Rejections under 35 U.S.C. §112, 1st paragraph and for Double Patenting**

Claims 18-19 were rejected under 35 U.S.C. §112, first paragraph, as being indefinite, and were also provisional rejected on the ground of nonstatutory obviousness-type double patenting over claims 36-45 of copending Application No. 12/361,626. Applicants respectfully traverse the rejections. Nonetheless, in the interest of further prosecution of the application, Applicants have cancelled claims 18-19, rendering the rejections moot.

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**Claim Rejections under 35 U.S.C. §102**

Claims 1, 4-5, 7-8, and 16-20 were rejected under 35 U.S.C. 102(a) as being anticipated by Sato (WO 03/070691). Specifically, the Examiner referenced the abstract and provided several examples of N-hydroxycarboxamide derivatives described by Sato. However, Sato does not describe N-hydroxycarboxamide derivatives that include an aliphatic group in the region of the derivatives that Applicants have designated “group A,” and claims reciting aliphatic groups were not rejected by the Examiner. Accordingly, Applicants have amended independent claim 1 to recite A being an aliphatic group. Support for the amendment can be found, for example, in the previously dependent claim reciting aliphatic groups (claim 2), which has been cancelled.

Applicants respectfully traverse the rejection of claim 8 as being anticipated by Sato. The compounds of Sato all include a methylene group at the position corresponding to Y in the claimed formula. However, claim 8 recites Y is  $(CH_2)_n$ , wherein n is 0. Because Sato recites compounds in which “n is 1” due to the presence of the methylene, but claim 8 requires n to be 0, claim 8 is not anticipated by Sato. However, because claim 8 recites A being an aromatic group, and claim 1 has been amended to recite A being an aliphatic group, claim 8 has been amended to be an independent claim and specifically recites the elements formerly provided by its dependency on claim 1.

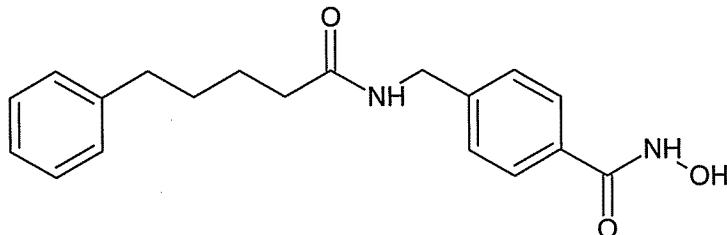
Claims 16-20 were also rejected over Sato. Claims 16 and 17 are dependent on claim 1, and should be allowable for at least the same reasons provided for claim 1. Claims 18 and 19 have been cancelled, and claim 20 depends from claim 8, which should be allowable for at least the same reasons provided for claim 8. Accordingly, Applicants respectfully request that the rejection of claims 1, 4-5, 7-8, and 16-20 under 35 U.S.C. 102(a) as being anticipated by Sato be withdrawn.

Claims 1-2, 7, 16-17, and 20 were rejected under 35 U.S.C. 102(b) as being anticipated by Bertolini *et al.* (U.S. Patent No. 6,034,096). Specifically, the Examiner indicated that the claims were anticipated by the compound 4-(5-phenylpentanamido)benzohydroxamic acid, which is described in Bertolini *et al.* and is shown below. Applicants respectfully traverse the

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rejection.



When correlating the structure of 4-(5-phenylpentanamido)benzohydroxamic acid to Applicants' formula, group A would be the portion of the structure to the left of the central carbonyl group of the structure shown. This portion is not an aliphatic group, as recited for group A in claim 1 (as amended), but rather is an "alkaryl" group in which the majority of the carbons are found in the aromatic region of the group. Aliphatic groups are defined in the art as "compounds composed of hydrogen and carbon that do not include aromatic groups." Because the region corresponding to group A in 4-(5-phenylpentanamido)benzohydroxamic acid includes an aromatic group, it does not anticipate claim 2, as originally submitted, or claim 1 which has been amended to incorporate claim 2. For at least the same reason, Bertolini *et al.* does not anticipate claims 16 and 17, which depend from claim 1. Bertolini *et al.* also does not anticipate claim 20, which depends from claim 8, for at least the reason that claim 8 recites  $n = 0$  for Y, whereas Bertolini *et al.* provides a compound in which "n" of the region corresponding to Y equals one as a result of being a methylene group. Accordingly, Applicants respectfully request that the rejection of claims 1-2, 7, 16-17, and 20 under 35 U.S.C. 102(b) as being anticipated by Bertolini *et al.* be withdrawn.

Claims 1-2, 6, and 16-20 were rejected under 35 U.S.C. §102(b) as being anticipated by Manfred Jung, Current Medicinal Chemistry, 2001, 8, 1505-1511. (Jung). Specifically, the Examiner indicated that Jung describes the acetyldinaline compound 20.

However, Applicants note that Jung does not describe the compounds of the claims as presently amended. Jung describes a molecule in which the position corresponding to Applicants' group A is a methyl group, which has a single carbon. However, the amended

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claims recite compounds with an aliphatic or aromatic group at A that includes from 3 to 14 carbons, which is at least two carbons more than provided by Jung at this position. Accordingly, Applicants respectfully request that the rejection of the indicated claims under 35 U.S.C. §102(b) as being anticipated by Jung be withdrawn.

In view of the above-described amendments and remarks, Applicants submit that claims 1, 3, 6-17, and 20-24 are in condition for allowance, and respectfully requests same. The Examiner is asked to contact the undersigned at the phone number listed below if there are any questions regarding the amendments or remarks provided herein.

Respectfully submitted,

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